

## **REMARKS**

Applicant notes that all amendments and cancellations of Claims presented herein are made without acquiescing to any of the Examiner's arguments or rejections, and solely for the purpose of expediting the patent application process in a manner consistent with the PTO's Patent Business Goals (PBG),<sup>1</sup> and without waiving the right to prosecute the amended or cancelled Claims (or similar Claims) in the future.

On January 7, 2009, Applicants' representatives, Tanya A. Arenson and David A. Casimir, conducted a telephone interview with Examiner Vaughn. Proposed claim amendments were discussed. The Applicants' representatives pointed to differences between the claims and the Shanahan reference cited by the Examiner.

The Examiner has rejected Claims 1 and 5-10 under 35 USC §103 as allegedly being obvious in light of Shanahan et al., US Patent Publication 2005/0022114 (hereinafter Shanahan). The Applicants respectfully disagree. However, for business purposes and to further the prosecution of the present application, while reserving the right to prosecute the original or similar claims in the future, the Applicants have amended the claims to recite specific types of documents. Support for this amendment can be found, for example, on page 9, lines 5-25 and page 11, lines 13-17. The Applicants submit that Shanahan does not teach or suggest methods or systems for analyzing documents selected from assignments, students' manuscripts, grant applications and journal manuscripts.

The Applicants further submit that Shanahan does not teach or suggest either that the standardized formatted objects are images or that contextual markups are images that are added as invisible images that map to the image file.

The Applicants submit that Shanahan does not teach or suggest contextual markups that are **images** that are added to an invisible image that maps to an image file. The Examiner has provided no evidence that Shanahan teaches or contemplates adding invisible **image** layers to an **image** file. Indeed, Shanahan specifically contemplates the use of Document Object Model and extended markup language to associate metadata to a document (paragraph 0142). Indeed, the meta data of Shanahan, while associated with its document is not intended to be viewed as an

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<sup>1</sup> 65 Fed. Reg. 54603 (Sept. 8, 2000).

overlay on the document. Such standards are not images. As such, Shanahan teaches away from the use of an invisible image file as way of marking up documents.

The Applicants submit that the Examiner has not demonstrated a *prima facie* case of non-obviousness because Shanahan does not teach or suggest every element of the claimed invention. In addition, the Examiner has provided no evidence (explicit or implicit) as to why one of skill in the art would be motivated to modify the teachings of Shanahan to arrive at the presently claimed invention, nor does such a motivation exist. As such, the rejection under U.S.C. 103 is improper and the rejection should be withdrawn.

The Applicants have added new Claims 14 and 15 that recite methods wherein the user is an instructor or a peer reviewer. Support for new Claims 14 and 15 can be found, for example on page 5, lines 11-14 and page 11, line 29 to page 12, line 2 of the specification.

## **CONCLUSION**

All grounds of rejection of the Final Office Action of October 6, 2008 have been addressed and reconsideration of the application is respectfully requested. It is respectfully submitted that the claims should be allowed. Should the Examiner have any questions, or if a telephone conference would aid in the prosecution of the present application, Applicants encourage the Examiner to call the undersigned collect at 608-218-6900.

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